

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Masayuki SHIMUZU et al. Confirmation No.: 3087
Appl. No. : 10/561,960 Examiner: E.E. Cadugan
I.A. Filed : June 22, 2004 Group Art Unit: 3726
For : BENDING APPARATUS, METHOD THEREOF, AND BENDING
TOOL

**RESPONSE TO RESTRICTION REQUIREMENT AND CONTINGENT ELECTION OF
SPECIES REQUIREMENT, WITH TRAVERSE**

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop AMENDMENT
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Restriction Requirement and contingent Election of Species Requirement of February 18, 2010, in which a thirty day period for Response was set to expire on March 22, 2010 (March 20, 2010 falling on a Saturday), the present Response and contingent Election being accompanied by a request for (five months) Extension of Time, Applicants hereby elect the invention identified by the Examiner as Invention I, to which claims 1-12 (as identified by the Examiner) are directed, and the Species identified by the Examiner as Species I-A, to which at least claims 1-9 and 11-12 are directed (not mutually-exclusive). Claims 1-8 and 11-12 are considered generic to each identified Species. However, the election of Invention I and Species I-A (as identified by the Examiner) is made with traverse for at least the reasons set forth below.

RESTRICTION REQUIREMENT

In the Restriction Requirement, the Examiner asserted that the application contains claims drawn to inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1, namely:

Group I, claim(s) 1-12, drawn to a “bending apparatus”.

Group II, claim(s) 13, drawn to a “bending method”.

Group III, claim(s) 14-16, drawn to a “bending method”.

Group IV, claim(s) 17-20, drawn to a “bending tool”.

The Examiner also identified WO 00/41824 (and family member U.S. Patent Application Publication No. 2003/0064871) as teaching the common features of the identified Groups of claims.

CONTINGENT ELECTION OF SPECIES REQUIREMENT

In the contingent Election of Species Requirement, the Examiner asserted that dependent claims 9 and 10 of Group I are directed to more than one species of the generic invention. The Examiner asserted that the claims of Group I are directed to Species that lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. The Species identified by the Examiner are as follows:

Species 1-A: A species wherein the process station formation device has a separator that has an arm which is rotatably mounted on an abutment of a back gauge, as set forth in at least claim 9; and

Species 1-B: A species wherein the process station formation device includes a fork-like separator with a pair of taper claws, as set forth in at least claim 10.

The Examiner also identified WO 00/41824 (and family member U.S. Patent Application Publication No. 2003/0064871) as teaching the common features of the identified Species.

Upon entry of the present Election, Applicants will have elected the invention identified by the Examiner as Invention I, to which claims 1-12 (as identified by the Examiner) are directed, and the Species identified by the Examiner as Species I-A, to which at least claims 1-9 and 11-12 are directed (or not mutually-exclusive). However, the election of Invention I and Species I-A (as identified by the Examiner) is made with traverse for at least the reasons set forth below.

Restriction Requirement

The Restriction Requirement asserts that claims of the various identified groups lack any “same or corresponding special technical features”. However, the Restriction Requirement does not identify any features of any claim as a “special technical feature”. Rather, the Restriction Requirement attempts to identify the same or corresponding features of claims of different identified groups, and then asserts that all such same or corresponding features are not special technical features in view of WO 00/41824. This analysis is incorrect and improper for at least the reasons set forth below.

According to the logic of the assertions in the Restriction Requirement, some claims do not have any special technical features, as all or substantially all of the features recited in such claims in an identified group are asserted to be common or corresponding to features of claims in other identified groups, and such features common to such claims are asserted by the Examiner to not constitute “special technical features”. Therefore, such claims would not be examined with any other claims under any conceivable scenario, though only because the Examiner has essentially already examined such claims in order to support a determination that such claims are

not properly examined with other claims. This provides *prima facie* evidence that no serious burden would exist in examining claims of such identified groups together.

Therefore, there is not and cannot be a serious burden in examining such claims, when the Examiner has already essentially examined all positively recited features of claims in one of two identified groups as variously described in the Restriction Requirement.

The standard by which the U.S. Patent and Trademark Office guides Examiners in requiring restriction under 35 U.S.C. §121 is set forth in MPEP Chapter 800. MPEP 803 sets forth that “if the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.” That is, according to MPEP § 803, an appropriate explanation must be advanced by the Examiner as to the existence of a serious burden if the Restriction Requirement were not required, and such an explanation is not provided in the Restriction Requirement.

The Restriction Requirement does not and can not provide an “appropriate explanation” of such burden, as set forth in MPEP § 803, as the Restriction Requirement indicates that all or substantially all of the features of various claims belonging to different identified groups have been examined. Additionally, the assertion that a serious burden exists is only provided with respect to the Election of Species requirement, and not with respect to the Restriction Requirement.

Therefore, when the Examiner performs a search for the features of claims of Group I, it is not believed that a serious burden would be placed on the Examiner to continue the examination of the remaining claims of other identified Groups in this application.

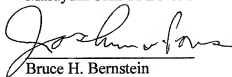
Contingent Election of Species Requirement

Similar to the reasons set forth above as to why the claims of all identified Groups should be examined, each of claims 9 and 10 should also be examined together notwithstanding the contingent Election of Species requirement. That is, each of claims 9 and 10 depend, directly or indirectly, from claim 1. No more than a minimal burden would be imposed in examining claims 9 and 10 together, particularly insofar as each of these claims depend in common from the same independent claim. Moreover, while the Election of Species Requirement alleges that a serious burden would be imposed in examining claims 9 and 10 together, no specific assertion is provided as to which basis exists for the belief that a serious burden would be imposed. Rather, the Election of Species Requirement sets forth at page 11 the various bases that may exist to support an assertion that a serious burden would be imposed, without specifying which basis or bases are specifically alleged to exist.

Therefore, due to an apparent lack of a serious burden, as recognized in MPEP 803 as being a prerequisite to a proper Restriction Requirement or Election of Species Requirement, Applicants request that the Restriction Requirement and contingent Election of Species requirements be withdrawn. Nevertheless, should the Examiner fail to reconsider and withdraw the outstanding Restriction Requirement and contingent Election of Species Requirement, Applicants hereby elect with traverse the invention identified by the Examiner as Invention I, to which (as identified by the Examiner) are directed, and the Species identified by the Examiner as Species I-A, to which at least claims 1-9 and 11-12 are directed (or not mutually exclusive). Claims 1-8 and 11-12 are considered generic to each identified Species.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,
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August 18, 2010
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